

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Gardella et al.	Confirmation No.:	1482
Serial No.:	10/564,744	Art Unit:	1654
371(c) Date:	March 3, 2006	Examiner:	Gupta, Anish
Customer No.:	21559		
Title:	CONFORMATIONALLY CONSTRAINED PARTHYROID HORMONE (PTH) ANALOGS		

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT

Applicants note that the patent term adjustment set forth in the Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) dated July 13, 2010 in the above-referenced patent application appears to be shorter than appropriate.

Applicants submit that the Applicant Delay was improperly calculated in view of the Information Disclosure Statements filed July 20, 2009 and June 22, 2010. This is explained in detail below.

*Applicant delay*

The Office calculated a total Applicant delay of 192 days. In arriving at this calculation, the Office calculated four periods of delay:

1. A period of 61 days for filing a response on July 6, 2009 to an Office action mailed February 6, 2009,
2. A period of 14 days for submission of an Information Disclosure Statement (IDS) on July 20, 2009 following a reply filed July 6, 2009,
3. A period of 25 days for filing a response on March 22, 2010 to an Office action mailed November 25, 2009, and

4. A period of 92 days for submission of an IDS on June 22, 2010 following a reply filed March 22, 2010.

Applicants do not dispute the calculation of the 61-day period or the 25-day period listed above. Applicants however believe that the 14-day period and the 92-day period are improperly calculated, as explained below.

*Information disclosure statement filed July 20, 2009*

37 C.F.R. § 1.704(c)(9) sets forth that:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed

Importantly, 37 C.F.R. § 1.704(d) notes an exception to this rule:

(d) A paper containing only an information disclosure statement in compliance with §§ 1.97 and 1.98 will not be considered a failure to engage in reasonable efforts to conclude prosecution (processing or examination) of the application under paragraphs (c)(6), (c)(8), (c)(9), or (c)(10) of this section if it is accompanied by a statement that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the information disclosure statement. This thirty-day period is not extendable.

Because each item of information cited in the July 20, 2009 IDS was first cited in a communication from foreign patent office in a counterpart application and was not received by any individual designated in §1.56(c) more than thirty days prior to the filing of the IDS, Applicants should not be charged with 14 days of delay. The July 20, 2009 IDS included a supplementary European Search Report from European Patent Application No. 04 77 8370, the European counterpart of the above-captioned

application. All references cited in this IDS were first cited in the Search Report. In addition, this IDS was filed within 30 days of the mailing date (July 3, 2009) of the Search Report. Accordingly, the Search Report was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the IDS. Applicants respectfully submit that this IDS falls under the exception set forth in 37 C.F.R. § 1.704(d). Accordingly, Applicants should not be penalized 14 days of delay for filing this IDS.

*Information disclosure statement filed June 22, 2010*

Applicants also should not be penalized 92 days of delay for the IDS filed June 22, 2010. As with the July 20, 2009 IDS, each item of information cited in the June 22, 2010 IDS was first cited in a communication from a foreign patent office in a counterpart application that was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the IDS. The June 22, 2010 IDS includes a first Office action received from the Japanese Patent Office in Japanese Patent Application No. 2006-520353, the Japanese counterpart of the above-captioned application. The reference cited in this IDS was first cited in the Japanese Office action. In addition, this IDS was filed within 30 days of the mailing date (May 24, 2010) of the Office action. Accordingly, the Search Report was not received by any individual designated in § 1.56(c) more than thirty days prior to the filing of the IDS. Finally, the June 22, 2010 IDS contains a statement to this effect. Thus, under 37 C.F.R. § 1.704(d), Applicants should not be penalized for 92 days from the filing of the March 22, 2010 reply to the filing of the June 22, 2010 IDS.

Because an IDS was filed on March 24, 2010 (two days following the submission of the March 22, 2010 reply), Applicants respectfully submit that the correct patent term adjustment for this period should be two (2) days of Applicant delay, rather than the 92 days calculated by the Office.

*Office delay*

Applicants do not dispute the calculation of 451 days of Office delay.

*Total patent term adjustment*

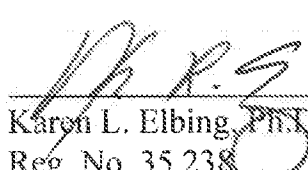
Applicants conclude that the Office delay associated with the above-captions application is 451 days, while the applicant delay is  $61 + 25 + 2$  days, for a total of 88 days. Thus, the present application is entitled to a total of  $451 - 88 = 363$  days of patent term adjustment under 37 C.F.R. § 1.703. Applicants request that the patent term adjustment determination be corrected accordingly.

CONCLUSION

Applicants respectfully request that the Office correct patent term adjustment as explained above. Transmitted herewith is \$200.00 in payment of the fee set forth in 37 C.F.R. § 1.18(e). If there are any additional charges or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: 07 October 2010

  
\_\_\_\_\_  
Karen L. Elbing, Ph.D.  
Reg. No. 35,238

Clark & Elbing LLP  
101 Federal Street  
Boston, MA 02110  
Telephone: 617-428-0200  
Facsimile: 617-428-7045